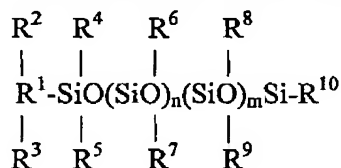


## REMARKS

The examiner rejected claims 7-13 under 35 U.S.C. §103(a) over U.S. Patent 6,365,141 (Nye) in view of U.S. Patent 6,043,388 (Perry) because the examiner argues that Nye discloses a method of reacting a silhydryde-functional polysiloxane with a terminally unsaturated aralkylene in the presence of a supported platinum catalyst to afford an aralkylsiloxane that reads on the limitation of the applicants' pentasiloxane. The examiner admits that the difference between Nye and this invention is the requirement of the specific method for preparing  $\text{HMe}_2\text{SiO}(\text{SiMe}_2\text{O})_3\text{SiMe}_2\text{H}$  or the use of a mixture comprising  $(\text{HMe}_2\text{SiO})(\text{SiMe}_2\text{O})_3(\text{SiMe}_2\text{H})$  and  $\text{HMe}_2\text{SiOSiMe}_2\text{H}$ . The examiner further argues that Perry discloses a method of preparing a  $(\text{HR}_2\text{SiO})(\text{SiR}'_2\text{O})_3(\text{SiR}_2\text{H})$  by reacting  $\text{HR}_2\text{SiOSiR}_2\text{H}$  in the presence of sulfonic acid where R and R' can be methyl. The examiner further argues that the motivation for using Perry's process to afford  $\text{HMe}_2\text{SiO}(\text{SiMe}_2\text{O})_3\text{SiMe}_2\text{H}$  or a mixture comprising  $(\text{HMe}_2\text{SiO})(\text{SiMe}_2\text{O})_3(\text{SiMe}_2\text{H})$  and  $\text{HMe}_2\text{SiOSiMe}_2\text{H}$  is to provide these components in a simple, less expensive way. The examiner further argues that Perry's process can be solventless. The examiner concludes that it would have been obvious at the time of the invention to use Perry's method to prepare the  $\text{HMe}_2\text{SiO}(\text{SiMe}_2\text{O})_3\text{SiMe}_2\text{H}$  or a mixture comprising  $(\text{HMe}_2\text{SiO})(\text{SiMe}_2\text{O})_3(\text{SiMe}_2\text{H})$  and  $\text{HMe}_2\text{SiOSiMe}_2\text{H}$  for use in Nye's process.

Nye discloses the use of certain aralkylsiloxane compounds in a personal care composition (col. 1, lines 6-31, field of the invention). The problem to be solved by Nye is to provide a product without impurities such as side products and catalyst residues, which are undesirable in the context of using the product in a personal care composition (col. 1, lines 16-23). In a preferred embodiment, the aralkylsiloxane comprises a compound of the formula I:



where  $\text{R}^1$ ,  $\text{R}^2$ ,  $\text{R}^3$ ,  $\text{R}^4$ ,  $\text{R}^6$ ,  $\text{R}^7$ ,  $\text{R}^8$ ,  $\text{R}^9$ , and  $\text{R}^{10}$  are each methyl and  $\text{R}^5$  is aralkyl, n is 1 and m is 2 (col. 1, line 65 to col. 2, line 38 and col. 3, lines 6-10). Nye discloses various methods for making aralkylsiloxanes. In a preferred embodiment, the aralkylsiloxane is made by contacting a silylhydryde-functional polysiloxane with a terminally unsaturated arylalkylene (col. 3, lines 24-45).

Perry discloses a method of preparing organohydrogenpolysiloxanes comprising the solventless reaction of a 1,1,3,3,-tetraalkyldisiloxane  $\text{HR}_2\text{SiOSiR}_2\text{H}$  with a hexaalkylcyclotrisiloxane  $(\text{R}'_2\text{SiO})_3$  in the presence of linear phosphonitrile chloride to produce  $(\text{HR}_2\text{SiO})(\text{SiR}'_2\text{O})_3(\text{SiR}_2\text{H})$ , where R and R' are independently monovalent alkyl or haloalkyl groups (Abstract).

To rely on a reference as a basis for an obviousness rejection, the reference must be analogous prior art. The determination whether a reference is analogous is two-fold. The reference must either be within the field of the inventor's endeavor or, if not, the reference must be reasonably pertinent to the particular problem the inventor was trying to solve, MPEP §2141.01(a).

The disclosure of Nye is discussed above. This invention relates to a high refractive index silicone oil and high refractive index silicone oil mixture (p. 1, paragraph 2, field of the invention). The problem to be solved by this invention is to reduce changes in refractive index upon volatilization (pp. 1-2, paragraphs 3-5). Nye and this invention are not within the same field of endeavor. The field of Nye is the use of certain aralkylsiloxane compounds in a personal care composition (col. 1, lines 6-31, field of the invention) while the field of this invention is a high refractive index silicone oil and high refractive index silicone oil mixture (p. 1, paragraph 2, field of the invention). Furthermore, Nye is not pertinent to the problem to be solved by this invention because the problem to be solved by Nye is to provide a product without impurities such as side products and catalyst residues, which are undesirable in the context of using the product in a personal care composition (col. 1, lines 16-23). In contrast, the problem to be solved by this invention is to provide a high refractive index silicone oil and a high refractive index silicone oil mixture having reduced timewise changes in refractive index due to volatilization of phenyl-type silicone oil in low molecular weight region and to provide a high refractive index silicone oil and a high refractive index silicone oil mixture that do not suffer from high volatility (pp. 1-2, paragraphs 3-5). Therefore, Nye is nonanalogous art because Nye is not within the same field of endeavor as this invention, and Nye is not pertinent to the problem to be solved by this invention. Therefore, the applicants respectfully request that the rejection of claims 7-13 under 35 U.S.C. §103(a) over U.S. Patent 6,365,141 (Nye) in view of U.S. Patent 6,043,388 (Perry) be withdrawn because the obviousness rejections are precluded based on disclosures from nonanalogous art.

Furthermore, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure, MPEP §2142.

One skilled in the art would recognize that there is no motivation to combine Nye and Perry. A prior art reference must be considered in its entirety, *i.e.*, as a whole. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, MPEP §2141.03. Here, using the method of Perry to produce organohydrogensiloxanes in the method of Nye would not produce the preferred embodiment of Nye. This is because the organohydrogensiloxanes produced by the method of Perry have Si-H at the terminals and not at the pendant positions. One skilled in the art would recognize that using organohydrogensiloxanes having Si-H at the terminals and not at the pendant positions would produce aralkylsiloxanes having terminal aralkyl groups and not pendant aralkyl groups. However, in the preferred embodiment of Nye, the aralkylsiloxane has pendant aralkyl groups, not terminal aralkyl groups. Nye already discloses various methods for preparing the aralkylsiloxane compounds at col. 3, lines 24-45. Nothing in the disclosures of Nye and Perry provides a motivation to disregard the methods disclosed by Nye and substitute the method of Perry for producing organohydrogensiloxanes into the method of Nye because the organohydrogensiloxane produced by the method of Perry would not produce the preferred aralkylsiloxane compound of Nye. Therefore, the first criterion for establishing a *prima facie* case of obviousness has not been met because there is no suggestion or motivation in the disclosure of Nye or Perry that would motivate one of ordinary skill in the art to modify the disclosure of Nye to use the method of Perry to produce the organohydrogensiloxane because Nye already discloses methods for preparing the aralkylsiloxanes and modifying these methods to use the organohydrogensiloxane produced by the method of Perry would not produce the preferred embodiment of Nye. Since one of the required criteria is missing, a *prima facie* case of obviousness has not been established for claims

7-13 over Nye in view of Perry. Therefore, the applicants respectfully request that the rejection of claims 7-13 under 35 U.S.C. §103(a) over U.S. Patent 6,365,141 (Nye) in view of U.S. Patent 6,043,388 (Perry) be withdrawn.

The examiner rejected claims 7-13 under 35 U.S.C. §103(a) over U.S. Patent 3,839,384 (Morehouse) in view of U.S. Patent 5,300,669 (Akamatsu) and Perry because Morehouse discloses a method for preparing a pentasiloxane that reads on applicants' pentasiloxane. The examiner admits that Morehouse differs from this invention in the requirements of a) the hydrosilylation being carried out in the presence of a supported platinum catalyst and b) the specific method for preparing  $\text{HMe}_2\text{SiO}(\text{SiMe}_2\text{O})_3\text{SiMe}_2\text{H}$  or a mixture comprising  $(\text{HMe}_2\text{SiO})(\text{SiMe}_2\text{O})_3(\text{SiMe}_2\text{H})$  and  $\text{HMe}_2\text{SiOSiMe}_2\text{H}$ . The Examiner further argues that Akamatsu discloses a process of hydrosilylating 1,1,3,3-tetramethyldisiloxane with alpha-methylstyrene in the presence of chloroplatinic acid or platinum on inorganic powder, therefore, Akamatsu suggests that chloroplatinic acid and platinum on inorganic powder are interchangeable. The Examiner further argues that it would have been obvious to one of ordinary skill in the art to use platinum on inorganic powder as a hydrosilylation catalyst in the process of Morehouse based on the disclosure of Akamatsu. The Examiner further argues that Perry discloses a method of preparing a  $(\text{HR}_2\text{SiO})(\text{SiR}'_2\text{O})_3(\text{SiR}_2\text{H})$  by reacting  $\text{HR}_2\text{SiOSiR}_2\text{H}$  in the presence of sulfonic acid where R and R' can be methyl. The examiner further argues that the motivation for using Perry's process to afford  $\text{HMe}_2\text{SiO}(\text{SiMe}_2\text{O})_3\text{SiMe}_2\text{H}$  or a mixture comprising  $(\text{HMe}_2\text{SiO})(\text{SiMe}_2\text{O})_3(\text{SiMe}_2\text{H})$  and  $\text{HMe}_2\text{SiOSiMe}_2\text{H}$  is to provide these components in a simple, less expensive way.

Morehouse discloses a polyether urethane foam (Title). The field of endeavor of Morehouse is to produce a high resilience polyurethane foam and the use of certain organosilicon surfactants in production of such foam (col. 1, lines 18-20). The problem to be solved by Morehouse is to provide a foam without irregular cell structure and without shrinkage (col. 1, lines 34-50).

This invention relates to a method of preparing a high-refractive-index optical silicone oil having a refractive index of from 1.45 to 1.50 at 25 °C and a high-refractive-index optical silicone oil mixture having a refractive index of from 1.45 to 1.50 at 25 °C (p. 1, paragraph 2). The field of this invention is to provide a high refractive index silicone oil and a high refractive index silicone oil mixture (p. 1, paragraph 2). The problem to be solved by this invention is to

reduce timewise changes in refractive index due to volatilization of phenyl-type silicone oil in low molecular weight region and to provide a high refractive index silicone oil and a high refractive index silicone oil mixture that do not suffer from high volatility (pp. 1-2, paragraphs 3-4).

To rely on a reference as a basis for an obviousness rejection, the reference must be analogous prior art. The determination whether a reference is analogous is two-fold. The reference must either be within the field of the inventor's endeavor or, if not, the reference must be reasonably pertinent to the particular problem the inventor was trying to solve, MPEP §2141.01(a).

Morehouse is nonanalogous to this invention because Morehouse is not within the field of the applicants' endeavor, and Morehouse is not pertinent to the problem the applicants' were trying to solve. The field of Morehouse is to produce a high resilience polyurethane foam and the use of certain organosilicon surfactants in production of such foam (col. 1, lines 18-20). In contrast, the field of this invention is a high refractive index silicone oil and a high refractive index silicone oil mixture (p. 1, paragraph 2). The fields of Morehouse and this invention are completely different. The problem to be solved by Morehouse is to provide a polyether urethane foam without irregular cell structure and without shrinkage (col. 1, lines 34-50). In contrast, the problem to be solved by this invention is to provide a high refractive index silicone oil and a high refractive index silicone oil mixture having reduced timewise changes in refractive index due to volatilization of phenyl-type silicone oil in low molecular weight region and to provide a high refractive index silicone oil and a high refractive index silicone oil mixture that do not suffer from high volatility (pp. 1-2, paragraphs 3-5). Therefore, Morehouse is not pertinent to the problem the applicants' were trying to solve because the problem Morehouse was trying to solve is different. Therefore, the applicants respectfully request that the rejection of claims 7-13 under 35 U.S.C. §103(a) over U.S. Patent 3,839,384 (Morehouse) in view of U.S. Patent 5,300,669 (Akamatsu) and Perry be withdrawn because the obviousness rejections are precluded based on disclosures from nonanalogous art, and Morehouse is nonanalogous.

The applicants have particularly pointed out and distinctly claimed the subject matter that they regard as their invention, and the instant invention is novel and unobvious. Reconsideration of the application is requested.

The present reply is being submitted within the three month period for response to the outstanding office action. Although the applicants believe in good faith that no extensions of time are needed, the applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,  
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